

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOLENE M. DONNER

Appeal No. 2001-0669
Application No. 09/198,637

ON BRIEF

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-6, all the claims pending in the application. Appellant's amendment filed subsequent to the final rejection has not been entered.

As stated on page 1 of the specification, appellant's invention

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relates to a wrist cover and more particularly to a tubular-shaped wrist cover which may be slipped over the hand of a person for covering the upper portion of the person's hand, the person's wrist and the lower portion of the person's sleeve to prevent snow or the like from coming into contact with the person's hand, wrist and lower arm.

A further understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced in the appendix to appellant's brief.

The references applied in the final rejection are:

Samuels et al. (Samuels)	3,416,518	Dec. 17, 1968
Matthews	5,402,536	Apr. 4, 1995
MacMorran	5,827,207	Oct. 27, 1998
Gregory, minor et al. (Gregory)	5,864,886	Feb. 2, 1999
Ho (Brithis Application)	2,245,477	Jan. 8, 1992

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Samuels.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Samuels in view of Gregory.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Samuels in view of Ho.

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Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Samuels in view of MacMorran.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Samuels in view of Matthews.

Reference is made to appellant's brief (Paper No. 10) and to the examiner's answer (Paper No. 11) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Discussion

Considering first the rejection of claim 1 as being anticipated by Samuels, claim 1 sets forth a wrist cover "for covering the wrist of a user wearing a coat having sleeves and a hand covering having a thumb," said wrist cover comprising a flexible, generally tubular member having a central portion and forward and rearward ends, with the central portion being "adapted to be positioned loosely over a portion of the user's hand covering, wrist and lower sleeve area." Appellant contends (brief, page 5) that Samuels does not anticipate claim 1 because, among other things, the cover of Samuels is designed to fit snugly over a cast. In response to this argument, the examiner takes the position (answer, pages 6-7) that the

requirement that the central portion of the sleeve is "adapted to be positioned loosely" over a user's hand covering, wrist and lower sleeve area is a statement of intended use that does not structurally distinguish over the sleeve of Samuels. The examiner also appears to be of the view that the central portion of Samuels' sleeve 10 is, in fact, capable of being positioned loosely over a hand covering worn by a user, within the broad meaning of the claim language "positioned loosely."

It is by now well settled that there is nothing intrinsically wrong in defining something by what it does rather than by what it is. *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971). With respect to the "adapted to be positioned loosely" language found in claim 1, while such language does not require the claimed wrist cover to be loosely positioned over a user's hand covering, wrist and lower sleeve area, this language does impart structural limitations to the claimed wrist cover in the sense that, to satisfy this language, a device must be *capable* of performing the recited function or use. *See, for example, In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971) and *In re Swinehart*, 439 F.2d at

212, 169 USPQ at 228. Hence, if a prior art device reasonably appears to inherently possess the capability of functioning in the manner claimed, anticipation exists regardless of whether there is a recognition that the prior art device could be used to perform the claimed function. *See, for example, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

In the present case, while we appreciate that sleeve 10 of Samuels is intended to be positioned over an arm cast with the thumb of the user extending through the opening 16, we do not agree with the examiner's position to the effect that said sleeve is inherently capable of functioning in the manner called for in claim 1, that is, "adapted to be positioned loosely over a portion of user's hand covering, wrist and lower sleeve area." To begin, Samuels' disclosure at column 2, lines 52-54, that the sleeves thereof are sized to *snugly fit* over the cast with which they are being used indicates to us that sleeve 10, if used to cover portions of the lower arm, wrist and hand of a person wearing a coat having a sleeve and a hand covering having a thumb, would likely also fit in a snug manner thereover.

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Moreover, Samuels' disclosure at column 2, lines 54-56, that the sleeves thereof are made in their entirety of stretchable elastic material which, because of their inherent resiliency, can be used with a plurality of different size casts, suggests to us that sleeve 10 also would not necessarily loosely fit over the hand covering, wrist and lower sleeve area of a person of, for example, small stature. In this regard, while it is possible that the sleeve of Samuels may function to loosely surround portions of a hand, wrist and forearm in the manner called for in claim 1, the mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to establish inherency. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In short, the disclosure of Samuels does not provide an adequate factual basis to establish that the natural result flowing from following the teachings of that reference would be a wrist cover that is adapted to be positioned loosely over a portion of a user's hand covering, wrist and lower sleeve area, as now claimed. Accordingly, we cannot sustain the examiner's

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rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Samuels.

Concerning the § 103 rejections of dependent claims 2-6 further in view of Gregory, Ho, MacMorran or Matthews, even if we accept the examiner's position that it would have been obvious to modify the sleeve of Samuels to provide therein the additional features called for in the dependent claims, the modified sleeve still would not necessarily be capable of functioning in the manner called for in base claim 1. Accordingly, the standing rejection of claims 2-6 also cannot be sustained.

The decision of the examiner is reversed.

REVERSED

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IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

LJS/lp

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JUDGE STAAB

APPEAL NO. 2001-0669

APPLICATION NO. 09/198,637

APJ STAAB

APJ McQUADE

APJ COHEN

DECISION: **REVERSED**

PREPARED: Nov 14, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK